

**REMARKS**  
**§102 rejections**

In the 26 July 2007 Office Action claims 64, 66 – 69, 71 – 73, 75, 77 – 80, 82 – 84, 86 – 91 and 93 – 95 are rejected under §102 as being anticipated by "How to sort out premium drivers of post deal value" by Daniel Bielinski (hereinafter, Bielinski). The Examiner has cited the Bielinski document as a reference. The Assignee respectfully traverses the rejections for anticipation in two ways. First, by noting that the claim rejections fail under both standards of the APA. Second, by noting by noting that the Office Action has failed to establish a prima facie case of anticipation for any of the rejected claims. More specifically, the Office Action fails to establish a prima facie case of anticipation in as many as four separate ways for every rejected claim.

The first way in which the 26 July 2007 Office Action fails to establish a prima facie case of anticipation for many if not all of the rejected claims is that the Bielinski document fails to describe every element of the claim. MPEP 2131 notes that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The second way in which the 26 July 2007 Office Action fails to establish a prima facie case of anticipation for many if not all of the rejected claims is that the Bielinski document fails to provide the same level of detail that is present in the claim. MPEP 2131 notes that anticipation requires that:

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The third way in which the 26 July 2007 Office Action fails to establish a prima facie case of anticipation for many if not all of the claims is that the Office Action does not describe the basis in fact or technical reasoning that is required to support the allegations regarding allegedly inherent characteristics contained in the Bielinski document. MPEP 2112 notes that:

"In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

The fourth way in which the 26 July 2007 Office Action fails to establish a prima facie case of anticipation for many if not all of the claims is that the Office Action does not describe how Bielinski enables the completion of a single rejected claim.

The Assignee respectfully submits that the rejection of independent claim 64 can be traversed by noting that Bielinski: is missing elements contained in claim 64, provides insufficient detail regarding elements of claim 64, fails to enable claim 64 and that any alleged inherency of elements of claim 64 in the Bielinski document has not been explained. Elements of claim 64 not explicitly or inherently described in the Bielinski document include: segments of value selected from the group consisting of real options, derivatives, market sentiment and investments. Bielinski also lacks detail regarding the segments of value and any alleged inherency of the segments of value has not been explained. Simply put the statement that Bielinski describes real options, derivatives and/or market sentiment appears to be a material misstatement. The Assignee notes that there are still other ways in which the §102 rejection of claim 64 can be traversed. As a result of these deficiencies, a prima facie case that would support the anticipation rejection of claim 64 has not been established. Claims 64, claims 66 - 69 and 71 - 73 are directly dependent on claim 64 so the traversal of the claim 64 anticipation rejection also serves to traverse the rejection of these claims by establishing that the Examiner has failed to develop a prima facie case of anticipation for the independent claim on which they depend.

The Assignee respectfully submits that the rejection of independent claim 75 can be traversed by noting that Bielinski: is missing elements contained in claim 75, provides insufficient detail regarding elements of claim 75, fails to enable claim 75 and that any alleged inherency of elements of claim 75 in the Bielinski document has not been explained. Elements of claim 75 not explicitly or inherently described in the Bielinski document include: segments of value selected from the group consisting of real options, derivatives, market sentiment and investments. Bielinski also lacks detail regarding the segments of value and any alleged inherency of the segments of value has not been explained. Simply put, the statement that Bielinski describes real options, derivatives and/or market sentiment appears to be a material misstatement. The Assignee notes that there are still other ways in which the §102 rejection of claim 75 can be traversed. As a result of these deficiencies, a prima facie case that would support the anticipation rejection of claim 75 has not been established. Claims 77 - 80 and 82 - 84 are directly dependent on claim 75 so the traversal of the claim 75 anticipation rejection also

serves to traverse the rejection of these claims by establishing that the Examiner has failed to develop a prima facie case of anticipation for the independent claim on which they depend.

The Assignee respectfully submits that the rejection of independent claim 86 can be traversed by noting that Bielinski: is missing elements contained in claim 86, provides insufficient detail regarding elements of claim 86, fails to enable claim 86 and that any alleged inherency of elements of claim 86 in the Bielinski document has not been explained. Elements of claim 86 not explicitly or inherently described in the Bielinski document include: segments of value selected from the group consisting of real options, derivatives, market sentiment and investments. Bielinski also lacks detail regarding the segments of value and any alleged inherency of the segments of value has not been explained. Simply put the statement that Bielinski describes real options, derivatives and/or market sentiment appears to be a material misstatement. The Assignee notes that there are still other ways in which the §102 rejection of claim 86 can be traversed. As a result of these deficiencies, a prima facie case that would support the anticipation rejection of claim 86 has not been established. Claims 87 – 91 and 93 - 95 are directly dependent on claim 86 so the traversal of the claim 86 anticipation rejection also serves to traverse the rejection of these claims by establishing that the Examiner has failed to develop a prima facie case of anticipation for the independent claim on which they depend.

Summarizing the above, the 26 July 2007 Office Action the Assignee respectfully submits that the Examiner has failed to produce the evidence required to establish a prima facie case of anticipation for a single claim. The complete failure to identify anticipation at the claim level clearly illustrates the fact that the cited reference is not even remotely similar to the claimed invention. As noted in MPEP 2112, anticipation requires that a substantial identity be established. Taken together, these failures provide additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. The Assignee notes that there are still other ways in which the §102 anticipation rejections in the 26 July 2007 Office Action for claims 64, 66 – 69, 71 – 73, 75, 77 – 80, 82 – 84, 86 – 91 and 93 – 95 can be traversed.

### **§103 rejections**

In the 26 July 2007 Office Action, claims 70, 74, 81, 85, 92 and 96 are rejected under §103 as being unpatentable over Bielinski in view of Machine Learning Research – Four Current Directions by Thomas Diettrich (hereinafter Diettrich). The Assignee respectfully traverses the §103 rejections of claims 70, 74, 81, 85, 92 and 96 in two ways. First, by noting that the rejections fail under both standards of the APA and are therefore moot. Second, by noting that the cited combination of documents fails to establish a prima facie case of obviousness in a number of ways, including:

1. failing to explain how the theoretical combination would be completed;
2. teaching away from the theoretical combination proposed by the Examiner,
3. requiring a change in the principle of operation of each cited invention in order to enable replication of claimed functions, and
4. failing to teach one or more limitation for every claim,.

The Assignee also notes that there are still other ways in which all §103 obviousness rejections in the 26 July 2007 Office Action for claims 70, 74, 81, 85, 92 and 96 can be traversed. For example, the combination proposed by the Examiner would destroy the ability of the VBM method to function.

The first way the cited combination of documents apparently fails to establish a prima facie case of obviousness for claims 70, 74, 81, 85, 92 and 96 is by failing to explain how the teachings will be combined. It is well established that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). In spite of this well know requirement, the Office Action has not described the manner in which the teachings of these documents would be combined.

The second way the cited combination of documents apparently fails to establish a prima facie case of obviousness for claims 70, 74, 81, 85, 92 and 96 is by citing a combination of documents that teaches away from the proposed combination. *MPEP § 2145 X.D.2 provides that: "it is improper to combine references where the references teach away from their combination."* The cited combination of documents teaches away from the proposed combination in at a number of ways, including:

1. Incompatible methods. Bielinski teaches analyzing data in order to quantify the historical relationship between financial performance and the level of spending for different sub-components of value. Dietrich teaches analyzing historical data with an ensemble of models in order to learn rules. The Assignee is not aware of any way in which the ensemble of models can be combined with the Bielinski model to produce anything useful. Furthermore, as noted previously the Examiner has not explained how the theoretical combination would be made or how it would function.

The Assignee notes that are still other ways in which the two references teach away from the proposed theoretical combination.

Far from establishing a prima facie case of obviousness for claims 70, 74, 81, 85, 92 and 96, the cited combination of references in the 26 July 2007 Office Action provides additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious.

In the 26 July 2007 Office Action, claims 65 and 76 are rejected under §103 as being unpatentable over Bielinski in view of Kjeld Jenses and Paul Warren. The use of options theory to value research in the service sector. R&D Management 31,2, 2001. (hereinafter Jenses). The Assignee respectfully traverses the §103 rejections of claims 65 and 76 in two ways. First, by noting that the rejections fail under both standards of the APA and are therefore moot. Second, by noting that the cited combination of documents fails to establish a prima facie case of obviousness in a number of ways, including: failing to explain how the theoretical combination would be completed. It is well established that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). In spite of this well know requirement, the Office Action has not described the manner in which the teachings of these references would be combined. The Assignee also notes that there are still other ways in which all §103 obviousness rejections in the 26 July 2007 Office Action for claims 65 and 76 can be traversed. For example, Bielinski teaches a prohibition on the use of projections and the Jenses method requires projections to work.

#### **§112 rejections**

In the 26 July 2007 Office Action, claims 65 and 76 are rejected under §112 second paragraph as being indefinite. The Assignee respectfully submits that the amendment of these claims in the instant Office Action obviates these claim rejections.

### **Statement under 37 CFR 1.111**

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons the prior set of claims were amended was to put the application in form for allowance and issue.

### **Reservation of rights**

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

### **Conclusion**

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,

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